

REMARKS

Reconsideration of the present application is respectfully requested in view of the following remarks. Prior to entry of this response, Claims 1-71 were pending in the application, of which Claims 1, 29, and 59 are independent. In the Office Action dated September 22, 2004, Claims 29-58 were rejected under 35 U.S.C. § 101, Claims 29-71 were rejected under 35 U.S.C. § 112, Claims 29-71 were rejected under 35 U.S.C. § 103, and Claims 1-28 were allowed. Furthermore, Claims 29, 31-34, 59, and 60 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting and the specification was objected to. Following this response, Claims 1-71 remain pending in this application. Applicant hereby addresses the Examiner's objection and rejections in turn.

I. Objection to the Specification

In the Office Action dated September 22, 2004, the Examiner objected to the specification due to missing status information of a co-pending application. The specification has been amended, and Applicant respectfully submits that the amendment overcomes this objection and adds no new matter.

II. Rejection of the Claims Under 35 U.S.C. § 112, Second Paragraph

In the Office Action, the Examiner rejected Claims 29-71 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as their invention. Claims 29 and

59 have been amended, and Applicant respectfully submits that the amendment overcomes this rejection and adds no new matter.

III. Rejection of the Claims Under the Doctrine of Double Patenting

In the Office Action, the Examiner provisionally rejected Claims 29, 31, 59, and 60 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 11-12, 14, 17-18, and 20 of copending U.S. Patent Application No. 10/035,586. Furthermore, the Examiner provisionally rejected Claims 29, 31-34, 59, and 60 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 15, 17-20, 26, and 28 of copending U.S. Patent Application No. 10/028,375. The Examiner has stated that a timely filed Terminal Disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome this rejection. Applicant respectfully requests that the Examiner hold these rejections in abeyance until allowable subject matter has been indicated.

IV. Rejection of the Claims Under 35 U.S.C. § 101

In the Office Action, the Examiner rejected Claims 29-58 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claim 29 has been amended and Applicant respectfully submits that the amendment overcomes this rejection and adds no new matter. Support for this amendment can be found in the specification at least in paragraph 56.

V. Rejection of the Claims Under 35 U.S.C. § 103(a) Using *Orup*

In the Office Action, the Examiner rejected Claims 29-71 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,931,943 ("*Orup*") in view of what the Examiner alleges is obvious to a person having ordinary skill in the art. Applicant respectfully traverses this rejection.

Regarding Claim 29, the Examiner stated that *Orup* does not specifically disclose determining a format of the first/second floating point operand based upon floating point status information encoded within the first/second floating point operand. (See Office Action, page 4, lines 22-23.) In addition, the Examiner merely states that this missing element would be obvious to a person having ordinary skill in the art. (See Office Action, page 5, lines 5-9.) As a result, Applicant respectfully asserts that the Examiner has failed to make a *prima facie* case of obviousness. In order to make a *prima facie* case of obviousness, the Examiner must set forth prior art which teaches or suggests every claim limitation. (See MPEP § 2143

If the Examiner continues to rely on this unsupported contention, Applicant respectfully requests the Examiner to provide concrete and explicit support.

Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy (February 21, 2002)(stating that it is never appropriate to rely on common knowledge without evidentiary support as sole or principal evidence on which to base rejection); MPEP § 706 citing 37 C.F.R. § 1.104 (providing that when a rejection in an application is based on facts within the personal knowledge of an Examiner, the data should be stated as specifically as possible, *and the facts must be supported*, when called for by the applicant, by an affidavit from the Examiner); MPEP § 2144.03

(providing that the Examiner may only take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art and, if the Applicant traverses such an assertion, the Examiner *should cite a reference* in support of his or her position.).

In light of the above remarks, Applicant asserts that the rejection of Claim 29 is not supported by the cited art and withdrawal of the rejection is respectfully requested. Applicant asserts that the rejection of Claim 59 is also not supported by the cited art and should be withdrawn for the reasons outlined above in response to the rejection of Claim 29.

Dependent Claims 30-58 and 60-71 are also allowable at least for the reasons above regarding independent Claims 29 and 59, and by virtue of their respective dependencies upon independent Claims 29 and 59. Accordingly, Applicant respectfully requests withdrawal of this rejection of dependent Claims 30-58 and 60-71.

VI. Rejection of the Claims Under 35 U.S.C. § 103(a) Using *Huang*

In the Office Action, the Examiner rejected Claims 29-71 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,995,991 ("*Huang*") in view of what the Examiner alleges is obvious to a person having ordinary skill in the art. Applicant respectfully traverses this rejection.

Regarding Claim 29, the Examiner stated that *Huang* does not specifically disclose determining a format of the first/second floating point operand based upon floating point status information encoded within the first/second floating point operand. (See Office Action, page 6, lines 8-10.) In addition, the Examiner merely states that this

missing element would be obvious to a person having ordinary skill in the art. (See Office Action, page 6, lines 14-17.) As a result, Applicant respectfully suggest that the Examiner has failed to make a *prima facie* case of obviousness. In order to make a *prima facie* case of obviousness, the Examiner must set forth prior art which teaches or suggests every claim limitation. (See MPEP § 2143

If the Examiner continues to rely on this unsupported contention, Applicant respectfully requests the Examiner to provide concrete and explicit support.

Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy (February 21, 2002)(stating that it is never appropriate to rely on common knowledge without evidentiary support as sole or principal evidence on which to base rejection); MPEP § 707 citing 37 C.F.R. § 1.104 (providing that when a rejection in an application is based on facts within the personal knowledge of an Examiner, the data should be stated as specifically as possible, *and the facts must be supported*, when called for by the applicant, by an affidavit from the Examiner); MPEP § 2144.03 (providing that the Examiner may only take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art and, if the Applicant traverses such an assertion, the Examiner *should cite a reference* in support of his or her position.).

In light of the above remarks, Applicant asserts that the rejection of Claim 29 is not supported by the cited art and withdrawal of the rejection is respectfully requested. Applicant asserts that the rejection of Claim 59 is also not supported by the cited art and should be withdrawn for the reasons outlined above in response to the rejection of Claim 29.

Dependent Claims 30-58 and 60-71 are also allowable at least for the reasons above regarding independent Claims 29 and 59, and by virtue of their respective dependencies upon independent Claims 29 and 59. Accordingly, Applicant respectfully requests withdrawal of this rejection of dependent Claims 30-58 and 60-71.

VII. Rejection of the Claims Under 35 U.S.C. § 103(a) Using *Lynch*

In the Office Action, the Examiner rejected Claims 29-71 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,009,511 ("*Lynch*") in view of what the Examiner alleges is obvious to a person having ordinary skill in the art. Applicant respectfully traverses this rejection.

Regarding Claim 29, the Examiner stated that *Lynch* does not specifically disclose determining a format...based upon floating point status information encoded within...floating point operand. (See Office Action, page 8, lines 1-2.) In addition, the Examiner merely states that this missing element would be obvious to a person having ordinary skill in the art. (See Office Action, page 8, lines 9-12.) As a result, Applicant respectfully suggest that the Examiner has failed to make a *prima facie* case of obviousness. In order to make a *prima facie* case of obviousness, the Examiner must set forth prior art which teaches or suggests every claim limitation. (See MPEP § 2143.)

If the Examiner continues to rely on this unsupported contention, Applicant respectfully requests the Examiner to provide concrete and explicit support.

Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy (February 21, 2002)(stating that it is never appropriate to rely on common knowledge without evidentiary support as sole or principal evidence on which to base

rejection); MPEP § 706 citing 37 C.F.R. § 1.104 (providing that when a rejection in an application is based on facts within the personal knowledge of an Examiner, the data should be stated as specifically as possible, *and the facts must be supported*, when called for by the applicant, by an affidavit from the Examiner); MPEP § 2144.03 (providing that the Examiner may only take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art and, if the Applicant traverses such an assertion, the Examiner *should cite a reference* in support of his or her position.).

In light of the above remarks, Applicant asserts that the rejection of Claim 29 is not supported by the cited art and withdrawal of the rejection is respectfully requested. Applicant asserts that the rejection of Claim 59 is also not supported by the cited art and should be withdrawn for the reasons outlined above in response to the rejection of Claim 29.

Dependent Claims 30-58 and 60-71 are also allowable at least for the reasons above regarding independent Claims 29 and 59, and by virtue of their respective dependencies upon independent Claims 29 and 59. Accordingly, Applicant respectfully requests withdrawal of this rejection of dependent Claims 30-58 and 60-71.

VIII. Conclusion

In view of the foregoing remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims. The preceding arguments are based only on the arguments in the Office Action, and therefore do not address patentable aspects of the invention that

were not addressed by the Examiner in the Office Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability.

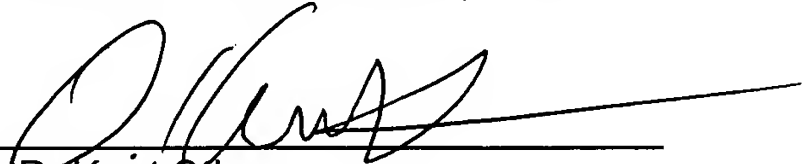
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 16, 2004

By: _____


D. Kent Stier
Reg. No. 50,640
(404) 653-6559